

**REMARKS**

Claims 1–20 are pending in the present application.

Claims 1, 11 and 18 were amended herein.

Reconsideration of the claims is respectfully requested.

**35 U.S.C. § 101 (Utility)**

Claims 1, 11 and 17 were rejected under 35 U.S.C. § 101 as reciting a use without setting forth any steps involved in the process, resulting in an improper process claim. This rejection is respectfully traversed.

Applicants disagree that recitation of an intended use in the preamble of an apparatus claim somehow magically converts that apparatus claim into an improper process claim. The cases cited in the Office Action involved actual method claims, not apparatus claims including a recitation of an intended use. Nonetheless, claim 1 has been amended. Claims 11 and 17 are method claims that include recitation of process steps, and therefore cannot properly be rejected as not “setting forth any steps involved in the process” as stated in the Office Action.

Therefore, the rejection of claims 1, 11 and 17 under 35 U.S.C. § 101 has been overcome.

**35 U.S.C. § 112, Second Paragraph (Definiteness)**

Claims 1, 11 and 17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

The Office Action states:

Claims 1, 11 and 17 provides for the use of a backplane, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Paper No. 11, page 2. Applicant's again disagree that recitation of an intended use within a preamble renders an apparatus claim indefinite. However, as noted above, claim 1 has been amended. Claims 11 and 17 are method claims reciting steps, such that the rejection is unfounded with regard to those claims.

Therefore, the rejection of claims 1, 11 and 17 under 35 U.S.C. § 112, second paragraph has been overcome.

**35 U.S.C. § 102 (Anticipation)**

Claims 1-2, 4, 7, 10-12 and 14-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by European Patent Application Publication No. 0 849 684 to *Williams et al.* This rejection is respectfully traversed.

A claim is anticipated only if each and every element is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. MPEP § 2131 at p. 2100-73 (8<sup>th</sup> ed. rev. 2 May 2004).

Independent claims 1 and 11 each recite that the primary master controller is inserted into the backplane (i.e., is located on a card inserted into a slot on the backplane). Such a feature is not

found in the cited reference. *Williams et al* discloses using a bus controller 22 mounted on and/or coupled to the backplane 20 rather than inserted into a slot 30, 32 or 34 on the backplane.

Independent claims 1 and 11 also each recite that the line replaceable unit, when first inserted into the backplane, is partially powered but does not have access to all buses or full power. Such a feature is not found in the cited reference. *Williams et al* teaches a power enable signal PE that controls switch 52 to either connect the card to Vcc or not--that is, either no power or full power. *Williams et al* does not teach or suggest partially but not fully powering the inserted card.

Therefore, the rejection of claim 1-2, 4, 7, 10-12 and 14-15 under 35 U.S.C. § 102 has been overcome.

**35 U.S.C. § 103 (Obviousness)**

Claims 3 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams et al* in view of U.S. Patent No. 5,754,785 to *Lysik et al*. Claims 6, 9 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams et al* in view of European Patent Application Publication No. 0 460 307 to *Gerhart et al*. Claims 8 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams et al* in view of U.S. Patent No. 5,996,083 to *Gupta et al*. Claims 18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams et al* in view of European Patent Application Publication No. 0 898 231 to *Tavallaei*. Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams et al* in view of *Tavallaei* and further in view of *Gerhart et al*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-128 (8th ed. rev. 2 May 2004). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a *prima facie* case of obviousness, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

As noted above, independent claims 1 and 11 recite at least one feature not found in *Williams et al.* Such feature(s) are also not found in the other cited references.

Independent claim 18 recites providing a controlled power ramp up to said circuit board card upon insertion into the slot. Such a feature is not found in the cited references. As conceded in the Office Action, *Williams et al.* does not disclose such a feature. The cited portion of *Tavallaei* does not teach a controlled power ramp up, but instead merely states that the power will take several microseconds to ramp up:

It is also preferred for hot-plugging that the card 410 should not disturb the bus portion 404 while it is being powered up. This means that the logic associated with

the on-card devices must be OFF as the power on the card 410 transitions from zero to its nominal value, which will typically take several microseconds.

*Williams et al*, column 12, lines 33–38. However, *Williams et al* does not teach or suggest controlling the power transition on the card 410.

Independent claim 18 also recited determining whether a voltage rail has failed. Such a feature is not found in the cited references. The cited portion of *Williams et al* merely teaches initialization and self-test on the inserted card, corresponding to the claim limitation of “running a power on self test on said circuit board card”:

If any on-card initialization or built-in-self-test (BIST) is required after power up, this activity must preferably be isolated from the bus portion 404 until the expansion card 410 is ready for operation.

*Williams et al*, column 12, lines 38–42. *Williams et al* does not teach determining whether a voltage rail has failed.

Independent claim 18 further recites starting a reset timer. Such a feature is not found in the cited references. As noted above, the cited portion of *Williams et al* teaches initialization and self-test on the inserted card, corresponding to the claim limitation of “running a power on self test on said circuit board card.” The cited portion of *Williams et al* does not teach starting a reset timer.

Therefore, the rejection of claims 3, 6, 8–9, 13 and 16–20 under 35 U.S.C. § 103 has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

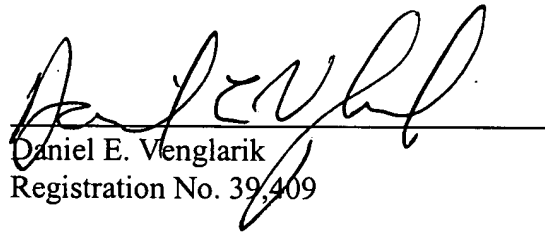
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: \_\_\_\_\_

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